

## REMARKS

Claims 9-16, 24-30 and 39-43 were examined. All claims were rejected. In response to the above-identified Office Action, Applicants amend claims 9 and 24 without adding new matter, but do not cancel any claims or add any new claims. Reconsideration of the rejected claims in light of the aforementioned amendments and the following remarks is requested.

### **I. Claims Rejected Under 35 U.S.C. § 101**

The Examiner rejected claims 9-16 and 24-30 as directed to non-statutory subject matter, apparently because they do not recite a useful tangible result among their limitations. However, in Applicants' review of the relevant statutes, MPEP sections, and Patent Office guidelines, no such requirement appears to be in effect. Section 101, for example, says nothing of claim elements, but merely grants to inventors or discoverers of new and useful processes, machines, manufactures, or compositions of matter, the right to obtain a patent therefor (subject to various conditions and requirements). This has been interpreted to mean that a "claimed invention as a whole must **accomplish** a practical application. That is, it must **produce** a 'useful, concrete and tangible result.'" (See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility; emphasis added.) There seems to be no requirement that the claim *recite* the result; only that the claimed structure or method *accomplish* or *produce* the result.

The claims under consideration here recite a result in their preambles: tracking file storage on a file-sharing or peer-to-peer network. It seems the Examiner accepts that such tracking is useful, but only wishes for it to be recited affirmatively in a claim element. However, a system comprising the elements recited in claim 9 cannot avoid accomplishing the desired result. Similarly, any entity that performs the operations listed in claim 24 will inevitably produce a database containing the useful tracking information. Nevertheless, for the sake of expediting the examination process, Applicants have amended claims 9 and 24 to recite a result in the claim body.

The Examiner also alleges that "the claim does not appear to do anything with the database to track files available." Applicants respectfully point out that both claim 9

and claim 24 recite “automatically stor[ing] the list of shared files in the database.” Clearly, the apparatus and method *do* do something with the database, and what they do results in the database containing useful file tracking information.

In a Memorandum issued April 12, 2007, by Deputy Commissioner John J. Love of the U.S. Patent and Trademark Office, the current examination guidelines for determining what is patentable subject matter has been clarified in a way that obviates the instant rejection. According to the Memorandum, as long as the specification describes a tangible, concrete and useful result, it is not necessary to cite this result in a claim to comply with Section 101. A copy of the two-page Memorandum is attached here. Here, both Applicant’s Specification and claims 9-16 and 24-30 themselves describe what is the purpose of the capability recited, which is to track file storage on a file-sharing or peer-to-peer network. Accordingly, the claims properly recite statutory subject matter.

Applicants believe that the aforementioned amendments and explanation are responsive to the issues raised by the Examiner’s rejections of the claims under 35 U.S.C. § 101, and respectfully request that these rejections be withdrawn.

## **II. Claims Rejected Under U.S.C. § 112**

The Examiner rejected claims 9-16 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement because the claim words “passively transferring” do not appear in the specification. Applicants have amended independent claim 9 to recite *intercept[ing]* the list of shared files, rather than *passively transferring* it. Intercepting is described at [0070] (and elsewhere in the specification and figures). This amendment is believed to be completely responsive to the rejection.

The Examiner also rejects claims 9-16 and 24-30 under 35 U.S.C. § 112, second paragraph, for antecedent basis errors. Specifically, a network that is first introduced with qualifiers “peer-to-peer or file-sharing,” is subsequently referenced as “the network.” Applicants have amended claims 9 and 24 to include the full six-word qualifier before each instance of the word “network,” thereby resolving any ambiguity in the meaning of that term. Withdrawal of the § 112 rejections is respectfully requested.

### III. Claims Rejected Under 35 U.S.C. § 102(e)

The Examiner rejected claims 24-26 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application No. 2002/0138471 by Dutta *et al.* (“*Dutta*”). Claim 24 recites a method of tracking file storage on a file-sharing or peer-to-peer network comprising a number of operations. *Dutta* also describes a method that occurs among computers in a peer-to-peer network, but *Dutta*’s method proceeds differently and produces a different result.

Generally speaking, *Dutta* collects information about searches for particular files, and the subsequent usage of the files that appear in a search result. It determines, in other words, which peer sources are most often accessed to obtain a particular file. In contrast, the method of claim 24 retrieves a listing of an entire library of files shared by a computer. The methods are incompatible, because *Dutta*’s method operates on information about files that are actually retrieved, while Applicants’ method collects information about files that may never be retrieved.

In particular, *Dutta* fails to disclose at least the claim element, “requesting a listing of an entire library of shared files from each of said plurality of computers connected to the file-sharing or peer-to-peer network.” Therefore, Applicants respectfully request that the rejection of claim 24 be withdrawn. Dependent claims 25 and 26 are also believed to be patentable over *Dutta* for at least the reasons discussed in support of claim 24. Applicants ask the Examiner to withdraw these rejections as well.

The Examiner rejected claims 39-43 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application No. 2003/0105831 by O’Kane (“*O’Kane*”). Claim 39 recites a method of reporting on shared files available through a peer-to-peer network comprising several operations which, if carried out, reliably produce a useful report. Applicants have reviewed *O’Kane*, paying particular attention to the paragraphs cited by the Examiner, and have found no teaching or suggestion of any similar method.

For example, the first element of claim 39 recites “obtaining a plurality of inventories of shared files, one inventory from each of a plurality of nodes in a peer-to-peer network.” The Examiner alleges that this element is disclosed in *O’Kane*’s paragraph [0042], which merely describes “a diagram illustrating a peer-to-peer

network in accordance with the invention.” The figure itself shows four computers: one connected to a box labeled “WAN” and three connected to an unlabeled box inside another unlabeled box. *O’Kane’s* ¶ [0042], read expansively, might establish that a peer-to-peer network includes a plurality of nodes which “communicate with each other in order to serve or host various requests or operations and to otherwise interact with each other,” but “various interactions” clearly fails to anticipate the specific claimed operation of “obtaining a plurality of inventories of shared files.”

Similarly, as to the claimed “storing the plurality of inventories” operation, the Examiner indicates *O’Kane’s* ¶ [0043], which purports to describe a client computer system, including “a permanent storage system.” Thus, *O’Kane’s* system apparently could store an inventory, if one had been obtained and there was some reason to store it, but none of the cited material (nor any other portions Applicants have reviewed) discuss or suggest using the system and network to perform these claimed steps.

As to the final claim element, “generating a report based on the inventories in the database,” the Examiner calls attention to a five-paragraph summary of what *O’Kane’s* “software trigger” allegedly accomplishes, focusing on tracking the movement of a data file through the peer-to-peer network and ensuring that a content owner is properly compensated at each stage. The precise mechanics of this tracking are described elsewhere and not cited by the Examiner, but they bear no resemblance to the claimed method, apart from the fact that they occur among systems that participate in a peer-to-peer network. A sixth paragraph of *O’Kane*, also cited as anticipating the “generating a report” limitation, describes a flow chart (mostly illegible in the published application) that appears to outline a process by which a user is forced to watch an advertisement before downloading a requested file. This paragraph also fails to teach or suggest the last claim element.

For at least the foregoing reasons, Applicants respectfully request that the Examiner withdraw the rejection of claim 39. In addition, as to dependent claims 40-43 (also rejected under § 102(e) in view of *O’Kane*), those claims are believed to be patentable for at least the reasons presented in support of their base claim. Applicants respectfully request that the Examiner withdraw the rejections of claims 40-43 as well.

#### **IV. Claims Rejected Under 35 U.S.C. § 103(a)**

The Examiner rejected claims 9-12 under 35 U.S.C. § 103(a) as unpatentable over *Dutta (supra)* in view of U.S. Patent Application No. 2004/0193900 by Nair ("*Nair*"). Claim 9 recites a system for tracking file storage on a file-sharing or peer-to-peer network that operates similarly to the method recited in claim 24. In particular, the system requests a list of all shared files from a plurality of computers connected to the file-sharing or peer-to-peer network. This element, at least, is different from what *Dutta* does (as discussed above). *Nair* is only relied upon for its alleged teaching of a manner of operation ("passively transferring") that has been amended in response to another ground of rejection. *Nair* fails to teach or suggest "intercepting" lists, as the claim now requires, so even assuming that it taught "passively transferring," and that *Nair* could properly be combined with *Dutta*, the references of record fail to make claim 9 obvious. For at least these reasons, Applicants respectfully request that the rejection of claim 9 be withdrawn.

Claims 10 and 11 depend on claim 9, and are rejected over the same combination of references (*Dutta* in view of *Nair*). As discussed above, the references are inadequate to support the rejection of the base claim, so claims 10 and 11 should be patentable for at least the same reasons. Applicants respectfully request that the Examiner withdraw the rejections of these claims.

Claims 13, 14, 29 and 30 are rejected under 35 U.S.C. § 103(a) as unpatentable over *Dutta (supra)* in view of *O'Kane (supra)*. The failures of both references have been discussed individually and at some length in the foregoing material, so Applicants merely point out again that *Dutta* does not request a list of all shared files, and that *O'Kane* does not produce reports. Applicants respectfully request that the Examiner withdraw the rejections of these claims.

### CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 9-16, 24-30 and 39-43, patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (503) 439-8778.

Respectfully submitted,  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Dated: September 21, 2007

/Mark C. Van Ness/

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MEMORANDUM

DATE: April 12, 2007  
TO: Technology Center Directors  
FROM: John J. Love *JL*  
Deputy Commissioner  
For Patent Examination Policy  
SUBJECT: Clarification of Interim Guidelines For Examination of Patent Applications  
for Subject Matter Eligibility

Certain inconsistencies have come to my attention in the application of the Interim Guidelines For Examination of Patent Applications for Subject Matter Eligibility, which are set forth in section 2106 of the Manual of Patent Examining Procedure (8<sup>th</sup> Ed. Rev. 5, Aug. 2006) (MPEP). The situation arises in the context of whether or not a claim is for a practical application of an abstract idea, law of nature, or natural phenomenon. As stated in the Interim Guidelines, a claim is for a practical application of an abstract idea, law of nature, or natural phenomenon when the claimed invention "transforms" an article or physical object to a different state or thing, or when the claimed invention produces a useful, concrete and tangible result. See MPEP 2106, subsection IV.C.2.

Focus on Result

A practical application in this context can be the result itself, and does not require that steps or additional limitations be added to the claim. As stated in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998):

Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces "a useful, concrete and tangible result"—a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.

It is the result that should be the focus. If the result has a real world practical application/use, then the test has been satisfied. The claim need not include the uses to which the result is ultimately put, just the result itself. Another example would be an improved method for measuring blood sugar levels in human beings. In this example, the end result is the blood sugar level which is a practical application for diagnostic purposes. Accordingly, reciting the improved method, and the result it achieves—the measurement of the blood sugar level—is all that is necessary for patent-eligibility. The diagnostic steps that occur after the determination of the blood sugar level need not necessarily be present in the claims in order for the claims to be statutory.

### Use of Specific Terminology

Another area of inconsistency surrounds the use of the terms such as "determining," "calculating," and similar expressions. Some object to these as not creating a tangible result. Such terms may in fact be sufficient to establish a tangible result. *See, e.g., State Street*, 149 F.3d at 1375, 47 USPQ2d at 1602 (holding the calculation of a number having a real world value and to be a "useful, concrete, and tangible result") and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999) (holding a method claim including the generation of a message record for an interexchange call to be statutory). The specification should be referred to for a meaning of the terms. *See In re Musgrave*, 431 F.2d 882, 893, 167 USPQ 280, 289 (CCPA 1970) ("[w]e cannot agree with the board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the processes to think. . . .").